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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,237	07/31/2003	Renaud Sergheraert	10272-0016-999	5189

20583 7590 05/07/2007

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EXAMINER	
HANDY, NIKKI R	
ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
05/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/633,237	SERGHERAERT ET AL.	
	Examiner	Art Unit	
	Nikki Handy	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *3-5 and 7-11* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/31/2003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-11 are pending.

Applicant's election without traverse of Group I (Claims 1, 2 and 6) in the reply on January 22, 2007 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are not enabled for the **prevention** pigmentation abnormalities and/or improving the quality of the fur.

For rejections under 35 U.S.C. 112, first paragraph, the following factors must be considered (In re Wands, 8 USPQ2d 1400, 1404 (CAFC, 1988)):

1) The nature of the invention.

2) The state of the prior art.

3) The relative skill of those in the art.

4) The predictability of the art.

5) The breadth of the claims.

6) The amount of direction of guidance provided.

7) The presence or absence of working examples.

8) The quantity of experimentation necessary.

1) Nature of the invention.

The nature of the invention relates to a domestic carnivore food composition for preventing pigmentation abnormalities and/or improving the quality of the fur that contains sources of proteins, fatty substances or rapid or slow carbohydrates and also a source of free tyrosine.

2) The state of the prior art.

The state of the prior art suggests that there is no means of **preventing** pigmentation abnormalities and/or improving the quality of fur by formulating a domestic carnivore food composition for this purpose. Morris et al. teach a supply to a food composition having high levels of tyrosine for **maintaining** desirable hair coloration or **reversing** undesirable hair discoloration. See US Application No. 2001/0014442 A1, page 1, paragraph 3).

3) Existence of working examples.

Working examples can be found on page 9 where the applicant teaches the effects of tyrosine given to a 7-year-old female cat. The observations of the study suggested that the food compostion containing free tyrosine was able to **correct** the pigmentation abnormalities in a domestic carnivore. However, the experiments **fail** to demonstrate the **prevention** of pigmentation abnormalities and/or improving the quality of the fur.

4) Breadth of the claims.

The claims are directed to the use of sources of proteins, fatty substances, rapid or slow carbohydrates and a source of free tyrosine encompassed in a domestic carnivore food composition in **preventing** pigmentation abnormalities and/or improving the quality of the fur. This type of treatment for dosmetic carnivores is too vast and would not be effective for all types carnivores. Hence the claims are broad.

5) Amount of direction and guidance provided by the inventor.

The amount of direction or guidance present is found on page 9 wherein in vivo studies are performed on 7-year-old female cats to demonstrate the preventive effect of tyrosine and other sources in pigmentation abnormalities and the improvement of the quality of the fur. Hence there is no guidance provided for the **prevention** of pigmentation abnormalities and/or improving the quality of the fur.

6) The predictability of the art.

There is a high degree of unpredictability that exists in the art. Morris et al. teach a supply to a food composition having high levels of tyrosine for **maintaining** desirable hair coloration or **reversing** undesirable hair discoloration. See US Application No. 2001/0014442 A1, page 1, paragraph 3). There is no known treatment for **preventing** pigmentation abnormalities and/or improving the quality of the fur, therefore ability to prevent such conditions is highly suspect.

In view of the teachings above, and the lack of guidance and/or exemplification in the specification, it is not believable that a domestic food composition for the **prevention** of pigmentation abnormalities and improving the quality of the fur can be achieved.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "at least one source of rapid or slow carbohydrates", and the claim also recites "in particular cereals" which is the narrower statement of the range/limitation.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 and 6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6-8, 14-16, 19-21, 27-29 and 32-34 of U.S. Patent No. 6,641,835 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and U.S. Patent No. 6,641,835 B1 (herein referenced as US '835) make

claim to a domestic carnivore food composition for preventing pigmentation abnormalities containing sources of proteins, fatty substances, cereals and free tyrosine. The instant application claims make reference to a domestic carnivore food composition while US '835 claims make reference to a method for correcting pigmentation abnormalities in the hair or fur of a domestic carnivore. The subject matter is overlapping in both the instant application and US '835. Therefore it would be obvious to one having ordinary skill in the art at the time of the invention to include the teachings of US '835 into the instant application because although US '835 recites a method for correcting pigmentation abnormalities US '835 makes claim to a domestic carnivore food composition. The identical food composition is claimed in the instant application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Morris et al. (US Application No. 2001/0014442 A1).

Morris et al. teach a food product or consumable product and method of use to prevent and reverse hair discoloration. More specifically, the amino acid tyrosine has been found as essential diet constituents for desirable hair coloration in any animal, particularly dogs and cats. See page 1, paragraph 3. Morris further teaches a consumable product utilized to maintain and restore hair (coat) color in animals. The product comprises a substrate and an effective amount of amino acid (tyrosine) with the amino acid being derived from a suitable source, such as, proteins. The effective amount of tyrosine to be added to the diet is at least approximately 0.05% by weight. See page 1, paragraph 14. Free tyrosine is referred to as L-tyrosine. See page 3, paragraph 29 and the applicant's instant specification, page 5. The food composition is fed to an animal (domestic carnivore), such as, a cat, dog or mink, etc. See page 2, paragraph 26. Commercial diets containing a total aromatic amino acid where tyrosine is about 45% in the concentration. See page 7, paragraph 48.

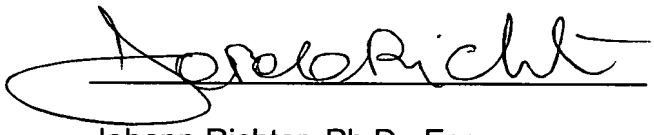
Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki Handy whose telephone number is (571) 272-9923. The examiner can normally be reached on Monday-Friday 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nikki Handy
Patent Examiner
Art Unit 1616



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